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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/488,037 01/19/00 WINTER

A HOE-92/F-253

HM22/1101

 EXAMINER

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NAZARIO GONZALEZ, P

ART UNIT	PAPER NUMBER
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1621

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DATE MAILED: 11/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/488,037	Applicant(s) Winter et al.
	Examiner Porfirio Nazario-Gonzalez	Group Art Unit 1621



Responsive to communication(s) filed on Oct 3, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-3 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-3 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed October 3, 2000 traversing the rejection of claims 1-3 on the basis of interference estoppel under 37 CFR §1.658© have been fully considered but they are not persuasive. Applicants argued that the facts in *Ex parte Tytgat*, 225 U.S.P.Q. 907(Bd. App. 1985) are not applicable in the instant case but rather that *Ex parte Deckler*, 21 U.S.P.Q.2d 1872 (Bd. App. 1991). Applicants further argued that the Karl's application and the instant application do not claim subject matter that overlap. The Examiner respectfully disagrees. The issue is whether Applicants claims overlap with the lost count (which the Karl et al. party won in the interference) and further whether Applicants move during the interference proceedings to narrow the interference count by filing a motion arguing that the subject matter now claimed in the instant application was patentably distinct from the proposed interference count (lost by Applicants). The Examiner believe that since Applicants failed to present that issue during the interference, Applicants are prevented from presenting them in *ex parte* proceedings. See *In re Kroekel, et al.*, 231 U.S.P.Q. 640 (CAFC 1986). In Kroekel, the Court denied Applicants' arguments that the claims were patentably distinct from the lost count and therefore should not be rejected on the grounds of interference estoppel on the basis that Kroekel et al. did not presented said arguments during the interference and therefore the rejection on the grounds of interference estoppel was

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proper. Thus, claims 1-3 stand rejected on the basis of interference estoppel under 37 CFR §1.658(c).

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The Examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG
October 30, 2000

Porfirio Nazario-Gonzalez
PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
1C GROUP 1200-1000